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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,296	02/06/2002	Jun Chuuma	100809-00165(SCEY 19.425)	9685
26304 7590 10/06/2008 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER LAMMIE, THERON F	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 10/06/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/072,296	<b>Applicant(s)</b> CHUUMA ET AL.	
	<b>Examiner</b> Theron F. Lammie	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6 Feb 2002, 17 March 2003, 16 July 2008</u> .                 | 6) <input type="checkbox"/> Other: _____                          |



## **DETAILED ACTION**

### ***Claim Objections***

Claim 4 is objected to because of the following informalities: Claim language is not clearly written and impairs its clarity.

Appropriate correction is required.

### **35 U.S.C. 112 sixth paragraph**

Claims 1-58 are also objected to under 35 U.S.C. 112 sixth paragraph as Applicant improperly used the “steps of” clause, with out defining the claimed steps.

Applicant should note that one skilled in the art would not be able to identify the structure, material or acts from description in the specification for performing the recited function if steps plus function language is to be employed, thus Applicant will be required to amend the specification to include the material incorporated by reference and to clearly link or associate the structure, material or acts to the function recited in the claim. Applicant should not be required to insert the subject matter described in the entire referenced document into the specification. To maintain a concise specification, Applicant should only include the relevant portions of the referenced document that correspond to the step-plus-function limitation(s) because as currently stated 35 U.S.C. 112 sixth paragraph could not be invoked due to the indefiniteness of the scope.

***Claim Rejections - 35 USC § 101 and § 112***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-58 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific asserted utility or a well established utility.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-58 also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-58 are further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention due to unclear terms in the claims inter alia, undefined claimed steps; more specifically, the order and condition for executing each step is not defined and the influence each step receives or transmits to the steps before and after is also unclear.

Applicant should also be wary that "...structure of repeating periodically changing

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information" in claims 1, 20, 39 and 58 as well as other problems in the remarks below leave Examiner uncertain of the boundaries of the claimed matter due to clarity issues; such as,

"the progressing speed of information", particularly in the relation with "changing information." Although there are descriptions "expressing by the number of predetermined objects a structure of repeating periodically changing information"

and "expressing the progressing speed of the information by the distance among the predetermined objects and a moving object that moves among the predetermined objects", since concrete relationship between "a structure of repeating periodically changing information" and "the number of predetermined objects", concrete relationship between "the progressing speed of the information" and "the distance among the predetermined objects and a moving object that moves among the predetermined objects", and the range of "expressing" are not clear, what extent of matters is specified by the description and what technical meaning lies in only "expressing";

The mentioned "including a "step" in at least one of claims 2-15, 17, 21-34 and 36 as Examiner can not identify what the "step" term includes;

The disclosed "arranging the predetermined objects in a polygon in response to the number of those objects" in claims 3,22, and 41, as Examiner remains unsure of the extent of matters specified by the description, particularly with the questionable case of "the number of objects";

The extent of the highly abstract "cycle" presented in claims 4, 23 and 42; particularly having "the moving object .... moves among the predetermined objects" and hence, persons skilled in the art would be uncertain of how to remake the invention with the moving range of "the moving object" said to be "making full circle of the polygon" as they could not identify the metes and bounds of the recited claim;

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Also deficient in lucidity is the extent of "multiple type of parameters used for forming objects mentioned in claims 5, 24 and 43; in particular, the relationship with the terms "object", "forming", and "parameter" as presented in the claims;

The extent of desired matters technically specified by the description "requesting a manipulation input from a user with the timing of the moving object overlapping with one of the predetermined objects" in claims 7-9, 26-28 and 45-47;

The "requesting from a user a manipulating input for suspending the progression of information"; specifically, the kind of processes "user" and "computer" or "program execution apparatus" execute for the desired "suspending" in claims 10, 29 and 48;

The description "arranging" in claims 11, 30 and 49 and the technical meaning of "arranging";

In claims 12-13, 31-32 and 50-51 the technical meaning for the "judging" success or failure and also the technical meaning for the "generating" notice information in response to the result of the stated "judging";

The disclosed "... mode specifying the manipulating input", "a mode requesting the user to estimate the manipulating input", and "switching between execution and no execution of the request for the manipulating input based upon the set mode", in claim 14, and the extent and relationship between each other and for example, the extent of "specifying the manipulating input" and the relationship between "specifying the manipulation input" and "execution and no execution of the request for manipulating input" and also the extent of "requesting the user to estimate the manipulating input" and the relationship between other components; further still, the extent of "execution" and "no execution" of "the request for manipulating input" and the relationship between each other and the relationship between setting "mode" and "switching between execution and no execution of the request for the manipulating input"; at least one reason indicated above addressing claim 7 can also be applied to "requesting the user to estimate the

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manipulating input". The very indication can also be applied to Claims 33 and 52;

The description of "changing the number of the predetermined objects" in claims 15, 34 and 53 leaves Examiner questioning the relationship between "the number of the predetermined objects" and "a structure of repeating periodically changing information" specifically with regard to "changing"; when the claims are analyzed based on the needs of the independent claims;

In claims 16, 35 and 54, since there is only one description "changing the number of the predetermined objects at one cycle before the timing when repeating cycle of the changing information varies", Examiner is in wonder of the specific components responsible for the change of "repeating cycle of the changing information" before one cycle, such as the "repeating cycle of the changing information" changed by outside components which are not included in the invention; as although there is a mention of "changing the number of the predetermined objects" particularly with "repeating cycle of the changing information," the specific extent of "changing" "the number" remains cloudy;

In claims 17, 36 and 55, since there is only a description "changing the distance among the predetermined objects" similar to previous complaints, the specific "how" the relationship between "the distance among the predetermined objects" and "progressing speed of the information" which is expressed by "the distance among the predetermined objects" and "...moving objects" "changing" is indeterminate;

Similarly, in claims 18, 37 and 56 are "the processing speed of the information" the specific extent of "changing" "the distance" would be confusing to persons skilled in the art;

Claims 19, 38 and 57 rely on unclear independent claims and thus, for this reason alone, their clarity is hindered;

In summary, the errors present in the application were too numerous and too unclear for



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examination as previously mentioned above;

Applicant should understand that the stated independent claims as presented for example, only thwart persons skilled in the art from understanding or constructing the claimed invention as desired.

The extreme complexity for understanding Applicant's provided claims makes Examination and making of the claimed invention by persons having ordinary skill in the art an impossibility; Applicant is therefore required to clarify the unclear data prior to continued prosecution;

Applicant is also welcomed to view Examiner's summarized claim rejections based on their obviousness below, regarding a basic understanding of what the claimed invention is; Applicant should not limit responses to the rejections to the analysis drawn by Examiner below but should further consider cited and searched references as possible evidence of the teachings.

Applicant is further warned that this application is subject to receiving a final rejection in the event the claimed matter in the response is still not found to be allowable.

### ***Claim Rejections - 35 USC § 103***

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Applicant states that the invention relates to a sound game and problems with scrolling

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as used in the prior art in specifications (on pg.1-3). However the examiner could find none of these features in claim 1. As presented, the claim is incredibly broad, relating only to "a method for expressing information" and with its broadness, it is clearly evident that any novelty possibly patentable is destroyed for example, with any analogue clock which displays minutes and hours.

Information in the form of time is expressed by predetermined markings in the form of numbers for the hours and dashes for the minutes. Hours generally take longer than minutes and indeed the hour markings are further apart than the minute markings. The progressing speed of the time is also expressed by moving objects generally referred to as "hands"; and with this reason alone claim 1 is clearly not allowable.

The above applies *mutatis mutandis* to claims 20, 39 and 58.

Reference is made to the following documents thought to be relevant by Examiner; the numbering will be adhered to in the rest of the discussion:

D1  
= US-A-3818693 .

D2  
= US-A-4090355

D3  
= EP-A-1033157

As it is not clear to which technical field the claims relate it is currently not possible to determine which features of the dependent claims might contribute to patentability.

It appears from Applicant's description that the application relates to a type of "bouncing ball" metronome. However, the use of a bouncing ball to indicate musical tempo is well-known and has been used since the 1920s to indicate song text in films when the audience may wish to sing along. The arrangement of indicators in a polygon to indicate

tempo is a known practice, eg. from D1 (see figure 1).

The use of the characteristics of "predetermined objects" to indicate characteristics of corresponding beats is known from D2 (see abstract), in a scrolling game of the prior art as known e.g. from D3 the skilled person has two possibilities for indicating a change of tempo, namely change the rate of scrolling or change the distance between beats. Changing the distance between the beats in a polygon representation would be an obvious adoption for the skilled person.

If Applicant still finds the above summary deficient in a computer-readable recording medium having recorded therein the information- expression processing program; Applicant is kindly asked to review the obvious teachings as disclosed by at least one reference enclosed (inter alia, ARMY MEN WORLD WAR: LAND SEA AIR (ARMY MEN) inter alia, pg. 2-3,6) as consistent with Applicant's fig.21; Applicant is further notified of the obviousness of using the mentioned metronome above with the well known teachings in at least one enclosed manual attached to amplify the predictable nature of the current invention.

Applicant is again kindly asked to review the comments disclosed above and submit new claims with their meanings clearly defined in the disclosure on which further examination is to be based; Applicant is further reminded to take account of all the above comments and enclosed references as possible threats in preparing/filing future responses.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theron F. Lammie whose telephone number is (571)270-1184. The examiner can normally be reached on 5/4/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Theron F Lammie/  
Examiner, Art Unit 3714

/Robert E Pezzuto/  
Supervisory Patent Examiner, Art  
Unit 3714

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